

REMARKS

Claims 1, 9, 12-27, and 33-42 are pending in this application, of which claims 33-39 have been withdrawn from consideration. Claims 1, 14, 40, and 42 have been amended. Claim 17 has been canceled. Hence, claims 1, 9, 12-16, 18-27, and 33-42 remain pending, of which claims 1, 9, 12-16, 18-27, and 40-42 remain under consideration.

Independent claims 1 and 42 have been amended to incorporate the limitations of dependent claims 14 and/or 17. Further, dependent claim 14 has been amended to incorporated a canceled limitation from independent claim 1. Support for these amendments can be found in the specification and the claims as originally filed. No new matter enters by way of the present amendment. As such, entry of the present amendment is respectfully requested and reconsideration of the subject application as amended is respectfully requested.

I. INTERVIEW SUMMARY

The Examiner is thanked for the courtesy of the personal interview conducted on June 22, 2005 with Applicants' representative, Darin Gibby. During the interview, the status of pending Claim 42 was discussed, and Applicants' representative gave authorization for a tentative Examiner's amendment should the Examiner otherwise consider the application in condition for allowance. However, the Office Action mailed June 30, 2005 was issued in lieu of an Examiner's amendment.

II. NON-ELECTED CLAIMS

Withdrawal of Claims 33-39 from consideration as a non-elected invention is hereby acknowledged. The claims will be cancelled upon indication of allowable subject matter.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1, 9, 12-32 and 40-42 stand rejected under 36 U.S.C. 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Withdrawal of this rejection is respectfully requested for at least the reasons which follow.

Claim 1 stands rejected for allegedly being indefinite due to the recitation of the claim term, “the multiplication product (final growth value) of which is between 1.36 and 1.58 inclusively”, which claim term should assertedly be between 1.46 and 1.58.

While not agreeing with the Examiner’s assertion, this claim limitation has been cancelled from Claim 1, and a similar limitation added to dependent claim 14. In claim 14, the claim limitation has been clarified in that the parenthetical term has been restated, and the obvious typographical error of 1.36 has been corrected, as noted by the Examiner. However, such amendment is not intended to narrow the scope of the original claim limitation. As such, it is submitted that the claims comply with 35 U.S.C. § 112, second paragraph, and withdrawal of this rejection is respectfully requested.

Claim 42 stands rejected as being indefinite due to the recitation of the claim term “the lofted foam”, which allegedly lacks antecedent basis in the claim. The claim has been amended to provide proper antecedent basis. As such, withdrawal of this rejection is respectfully requested.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)

A. Rejection Over Seidel, Aguerre, and Admitted Prior Art

Claims 1, 9, 12-23, 27 and 40-42 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the cited portions of U.S. Patent No. 4,476,600 to Seidel, *et al.* (hereinafter “Seidel”) in view of the cited portions of U.S. Patent No. 6,237,249 to Aguerre, *et al.* (hereinafter “Aguerre”), and the alleged admitted prior art page 11 of the instant specification. This rejection is respectfully traversed for at least the reasons which follow.

The presently amended claims relate to footwear comprising a base section and a strap section, both respectively formed as a part molded from lofted foam material. The strap section is attached to the base section such that the strap pivots relative to the base section with a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter to thereby maintain the strap section fixed relative to the base section.

Whatever else Seidel may show, the Examiner acknowledges that Seidel does not disclose a strap section pivotably connected to the upper, but asserts that it “would have been

obvious to connect a strap pivotable by rivets to the upper of Seidel '600 as taught by Aguerre '249 to better secure the footwear to the foot of the wearer." *Office Action mailed June 30, 2005* at page 3.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicants' disclosure. *See* M.P.E.P. §§2143.01 and 2143.03.

In a proper obviousness determination, the changes from the prior art must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the claimed invention. *See In re Chu*, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995). This includes what could be characterized as simple changes. *See, e.g., In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.). Only when the prior art teaches or suggests the claimed invention does the burden fall on the applicant to rebut that *prima facie* case. *See In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991). However, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

As mentioned above, the present claims require (1) that the strap section is formed as a second part molded from a second continuous piece of the lofted foam material, and (2) that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. As explained in the specification, such frictional forces help "to assure that strap 120 remains in place even when the Achilles part of the foot is not pressing against strap 120. Without such friction, strap 120 would succumb to gravity and fall to a position where the footwear piece may

not be maintained secure to the foot. At the same time, it can be desirable to design the frictional force at a contact point sufficient to allow strap 120 to be readily moved.” *Specification*, paragraph [0034], pages 7-8.

Contrary to the present claims, Aguerre discloses a “slide-type sandal, having an elastic and flexible rear heel strap 102.” Col. 4, lines 28-29. The rear heel strap disclosed by Aguerre is further described as being capable of being “freely rotated” between a first and second position. *See, e.g.*, Col. 7, lines 49-53; Col. 9, lines 29-34, and Col. 10, lines 48-50. In fact, in several embodiments, additional washers are added to ensure free rotation about the rotation point. As explained in Aguerre, “during rotation of the rear heel strap 202 about the rivet 244, it is common for the friction between the heel strap 202, the vamp 204 and the rivet 244 to interfere with smooth rotation. In order to facilitate smoother rotation of the rear heel strap 202 about the rivet 244, one of a first pair of nylon washer separators 246 is placed on the inside of the rear heel strap 202 and one of a second pair of nylon washer separators 248 is placed on the outside of the rear heel strap 202 as shown in FIG. 12.” Col 9, lines 20-29.

As such, it is submitted that Aguerre fails to teach a molded, lofted foam heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. Whatever else Seidel or Aguerre does disclose, they do not disclose the presently claimed invention. Even assuming *arguendo* that one of skill in the art would be motivated to attempt to incorporate the strap of Aguerre into the footwear taught by Seidel, the modified footwear would not incorporate each and every limitation of the present claims. More specifically, the resulting footwear would include an elastic, flexible heel strap designed to maximize free rotation about the connection point of the heel strap to the upper. There is no indication in Aguerre, Seidel, or the knowledge in the art that would motivate one of skill in the art to further modify the strap of Aguerre to arrive at the claimed molded lofted foam strap or frictional forces. Moreover, Aguerre actually teaches away from the presently claimed configuration.

As discussed above, the heel strap of Aguerre is designed to freely rotate about its connection point, and to specifically minimize friction to ensure free rotation through use of,

e.g., washer separators. Although the frictional forces of the present claims are preferably designed to allow for movement of the strap under certain conditions, the frictional forces are also sufficient to maintain a fixed strap position relative to the base, *e.g.*, “even when the Achilles part of the foot is not pressing against strap”. Aguerre specifically teaches to the contrary, and emphasizes the free rotation of the heel strap. As such, when taken as a whole, Aguerre teaches away from the presently claimed invention.

With respect to the expandable foam material, and the alleged “admitted prior art in the instant specification,” it is respectfully submitted that there must be some suggestion or motivation in the prior art to modify or combine the teachings of the prior art. Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *MPEP* § 2143.01. That the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification, without the benefit of hindsight reasoning. *See Fritch*, 23 U.S.P.Q.2d at 1783-84. Although a type of lofted foam material that is useful in connection with the present invention is known in the art, the actual use of that type of material in the specifically claimed context produced in a manner to obtain the specifically claimed final growth value was not known or suggested in the prior art. Further, the specific resin mixture characteristics in the context of molding a section footwear piece are not disclosed or suggested in the prior art. Absent a teaching or motivation in the art to suggest the desirability of the specifically claimed lofted foam material properties prior to the present invention, the use of a known starting material does not render the presently claimed invention obvious.

In addition, with reference to Claim 42 and certain of the dependent claims, Aguerre fails to specifically disclose that the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section, or that the distance from the first attachment point to the second attachment point along the rear sole perimeter is approximately the same distance from the first attachment point to the second

attachment point along the strap section. Further, Aguerre fails to specifically disclose that the strap section can pivot relative to the base section such that an inner portion of the strap section contacts an outer portion of the rear sole perimeter.

In the absence of a teaching or suggestion to modify the rear heel strap of Aguerre to arrive at the claimed configurations, for at least these additional reasons, the cited art does not render obvious each and every limitation of the present claims.

For at least these reasons, Applicants traverse the rejection of claims 1, 9, 12-23, 27, and 40-42, and respectfully request withdrawal of this rejection.

B. Rejection Over Seidel, Aguerre, and Sharpstein

Claims 1, 9, 12-23, 27 and 40-42 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seidel, in view of Aguerre and further in view of the cited portions of U.S. Patent No. 5,615,496 to Sharpstein, *et al.* (hereinafter “Sharpstein”).

Whatever else Sharpstein may disclose, it does not disclose a heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. As such, for at the least these reasons and those detailed above in Section A, this rejection is traversed and withdrawal of this rejection is respectfully requested.

Further, Sharpstein does not disclose or suggest the specifically claimed lofted foam material properties. Even assuming, *arguendo*, that the cited “low density foam” material of Sharpstein is a lofted foam material, Sharpstein does not disclose or suggest the specific final growth value in the dependent claims or resin mixture characteristics. In this regard, the Examiner alleges that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the growth value of the expandable foam, since it has been held that where the general conditions of a claim are discovered in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” Applicants respectfully traverse. A particular parameter must first be recognized as a result-effective variable, *i.e.*, a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *See In re*

Appl. No. 10/602,416
Amdt. dated August 16, 2005
Preliminary Amendment



PATENT

Antoine, 195 SUP 6 (CIPA 1977). *See also*, MPEP § 2144.05 (II)(B). Absent a recognition in the art of the growth value of the foam material as a critical parameter, one of skill would not be motivated to optimize the property to arrive at the claimed invention. For at least this additional reason, this rejection is traversed, and withdrawal is respectfully requested.

C. Rejection Over Seidel, Aguerre, Sharpstein, and Lamstein

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seidel, Aguerre and Sharpstein in view of the cited portions of U.S. Patent No. Des 416,667 to Lamstein, *et al.* (hereinafter "Lamstein").

Whatever else Lamstein may disclose, it does not disclose a heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. As such, for at the least these reasons and those detailed above in Sections A and B, this rejection is traversed and withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Darin J. Gibby
Reg. No. 38,464

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321
DJG/cl
60545797 v1